



Mark Chao
Takeda Pharmaceutical North America, Inc.
475 Half Day Road, Suite 500
Lincolnshire, IL 60069

In re Application of	:	
OI, et al.	:	
Application No.: 09/807,647	:	
PCT No.: PCT/JP99/05754	:	DECISION ON PETITIONS
Int. Filing Date: 19 October 1999	:	
Priority Date: 20 October 1998	:	UNDER 37 CFR 1.182 AND
Attorney Docket No.: 2560US0P	:	
For: 1, 5-BENZODIAZEPINE COMPOUNDS,	:	37 CFR 1.137(b)
THEIR PRODUCTION AND USE	:	

This decision is in response to applicant's "Petition For Revival of an International Application For Patent Designating The U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 29 June 2001 in the United States Patent and Trademark Office (USPTO). The petition is being treated as a petition for withdrawal of the holding of abandonment under 37 CFR 1.181 and in the alternative a petition to revive the present application pursuant to 37 CFR 1.137(b).

BACKGROUND

On 19 October 1999, applicant filed international application PCT/JP99/05754, which claimed priority of an earlier application filed 20 October 1998. 17 April 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 27 April 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 19 May 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 20 April 2001.

On 16 April 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by: a translation of the International Application into English; a combined declaration and power of attorney; an assignment document for recording; a Sequence Listing and a Sequence Listing Statement. Payment of the U.S. basic national fee was not provided.

On 20 April 2001, the application became abandoned for failure to pay the basic national fee for a U.S. national stage entry application.

On 26 June 2001, applicant was mailed a "Notification of Abandonment" (Form PCT/DO/EO/909) notifying applicant that the application was abandoned as to the United States of America for failure to provide the full U.S. Basic National Fee by thirty months.

On 29 June 2001, applicant filed the present petition accompanied by payment of the U.S. Basic National Fee and petition to revive fee.

DISCUSSION

I. Petition Under 37 CFR 1.181

Applicant seeks withdrawal of the holding of abandonment under the premise that applicant did provide authorization to charge the U.S. basic national fee to Deposit Account No.: 50-0799. This argument is without merit. Applicant did not provide a signature on the transmittal letter filed 16 April 2001 authorizing the charge of fees to Deposit Account No.: 50-0799. Contrary to applicant's claim, a "typed" signature is insufficient for authorization to charge fees. The "typed" signature in question is in fact nothing more than the lack of a signature. This is evidenced by the fact that applicant signed the assignment recordation sheet (applicant's exhibit B) which accompanied the transmittal letter. In that case, applicant properly executed the document and the \$40.00 fee was deducted as authorized. The full U.S. Basic National Fee could not be charged based on this signature as applicant only authorized deduction of the \$40.00 fee. Lastly, the fact that applicant has sufficient funds, an itemized return postcard and executed certificate of mailing are immaterial to the case at hand. None of these items provided authorization to charge Deposit Account 50-0799 the fee in question.

As such, applicant's petition to withdraw the holding of abandonment pursuant to 37 CFR 1.181 is **DISMISSED**.

II. Petition Under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the, "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" and (4) any terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where required).

With regard to Item (1), the proper response was payment of the full U.S. Basic National Fee. Applicant has authorized deduction of fee along with the present petition.

As to Item (2), applicant has authorized deduction of the \$1240.00 petition fee.

With regard to Item (3), applicant's statement that, "the entire delay in filing the required

reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" satisfies the requirement of 37 CFR 1.137(b)(3).

As to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate. Further, a review of the application file reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have been satisfied.

CONCLUSION

As stated above, the petition under 37 CFR 1.181 is **DISMISSED**.

For the reasons stated above, the petition for revival under 37 CFR 1.137(b) is **GRANTED**.

This application will be given an international application filing date of 19 October 1999 and a date of **29 June 2001** under 35 U.S.C. 371.

This application is being returned to the DO/EO/US for processing in accordance with this decision, specifically, issuance of a "Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495" (Form PCT/DO/EO/903).



Richard Cole
Legal Examiner
PCT Legal Office



Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459